IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
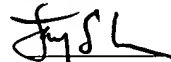
Applicant:	Fishman, Daniel	Atty Docket:	2857/105
Serial No.:	09/871,990	Art Unit:	2173
Date Filed:	May 31, 2001	Examiner:	Bonshock
Invention:	**System and Method for Transferring Web-Based Information**	Date:	April 28, 2006

CERTIFICATE OF MAILING

I hereby certify that this document, along with any other papers referred to as being attached or enclosed, is being deposited with the United States Postal Service as First Class Mail addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 28, 2006.

Jay Sandvos

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Following a Final Office Action dated January 30, 2006, Applicant submits the present Request for Formal Review, by a panel of examiners, of the legal and factual basis of the rejections pending in the present case, in accordance with the Pre-Appeal Brief Conference Pilot Program.[1]

Applicants believe that the issues are well-posed for appeal, and request formal review prior to appeal on the following grounds:

I. Background Synopsis of Subject Matter

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[1] Official Gazette of the United States Patent and Trademark Office, vol. 1296, Number 2, (July 12, 2005).

Appl. No. 09/871,990
Pre-Appeal Request for Review dated April 28, 2006
Further to Final Office Action of January 30, 2006

The independent claims of the instant application relate to a method by which a user selects web-based information and sends it over a computer network to a personal information management system.

II. Synopsis of Status of the Case

Claims 1-6, 8, 9, 11-16, 23 and 33 are pending in the application. In the latest office action of January 30, 2006, claims 1, 4-6, 8-17 and 23 are rejected under 35 USC 103(a) as being unpatentable over Narurkar (US 6 339 795).

III. Issue for Review Prior to Appeal:

A *prima facie* obviousness rejection is improper when claim limitations are not found in the cited prior art reference.

As set forth in MPEP §§ 2143[2] and 2143.03,[3] the cited prior art references must teach or suggest all claim limitations before a *prima facie* case of obviousness can be made. All of the pending claims require sending information over a computer network to a given application based on a user selected type of information – e.g., address or event. The cited prior art, however, does not teach this feature of the invention.

The invention relates to a system/method by which a user selects web-based information and sends it to a personal information management system that applies to a set of users. Claim 1 in part requires "identifying an information type ... selectable from a group including address and event." As a whole, claim 1 requires sending information

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[2] MPEP § 2143: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (Emphasis added.)

[3] MPEP § 2143.03: "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). ..."

Appl. No. 09/871,990
Pre-Appeal Request for Review dated April 28, 2006
Further to Final Office Action of January 30, 2006

to a given application based on a user <u>selected type of information</u> – e.g., address or event. Independent claim 11 is a system claim similar in substance to method claim 1.

By contrast, the closest prior art, the cited Narurkar reference, describes sending a <u>given type of information</u> – specifically, address information – wherein the user selects a particular application from a group of multiple different applications which will receive the information. Narurkar explicitly states that: "More specifically, the present invention relates to a user transparent process for exchanging and routing data representing postal address information between disparate data hosts." Col. 1, lines 20-23. Narurkar states that his sole focus is on a single given type of information – address information (i.e., contact data) – and he takes no interest at all in other types of information such as appointment information (i.e., calendar data).

Nor would one of ordinary skill in the art be motivated to alter Narurkar to provide the user-selected information type based data transfer required by claim 1. First of all, that would impermissibly alter the fundamental principle of Narurkar from data transfer of a given type (not user selected) of information to data transfer of a user selected one of many different information types. The MPEP does not permit an obvious rejection which acts in this way to alter the fundamental principle of the reference: "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE." MPEP §2143.01.

Not only is the rejection of claim 1 not permitted by the MPEP, it is also contrary to the explicit teachings of the Narurkar reference itself, which states that "the present invention relates to a user transparent process for exchanging and routing data." Col. 1, lines 20-22; see also, col. 3, lines 28-29, 34-35, and 42-43: "What is needed is a process for user-transparent exchange of data..." If in addition to selecting the destination application as taught by Narurkar, the user also had to select a type of information to transfer as is required by claim 1, then the process as a whole would no longer be "user-transparent" as Narurkar repeatedly insists.

Thus, the cited Narurkar prior art relied upon fails to teach or suggest sending information over a computer network to a given application based on a user <u>selected type of information.</u>

Appl. No. 09/871,990
Pre-Appeal Request for Review dated April 28, 2006
Further to Final Office Action of January 30, 2006

Given the above, it is submitted that the Examiner's rejection of this application is untenable, as has been consistently argued by the Applicants, and were this application to proceed to a full Appeal before the Board of Appeals and Interferences, the Examiner would clearly be reversed.
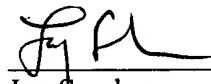
The arguments presented in the responses to each of the previous office actions and advisory actions associated with this application are also maintained.

IV. Conclusion

The cited Narurkar reference fails to disclose sending information over a computer network to a given application based on a user selected type of information. Thus, it is respectfully submitted that a *prima facie* case of obviousness cannot be properly made or sustained based on the plurality of references relied upon by the Examiner.

Therefore, allowance of all claims is respectfully requested.

Respectfully submitted,

Jay Sandvos
Registration No. 43,900
Attorney for Applicant

BROMBERG & SUNSTEIN LLP
125 Summer Street, 11th Floor
Boston, MA 02110-1618
(617) 443-9292

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